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09/168.770	10/05/98	SHAH	R	10 1042 (US)
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.

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IM52/1010

EXAMINER VARCOE JR, F

ART UNIT 1784	PAPER NUMBER
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DATE MAILED:


10/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/168,770	Applicant(s) Shah et al.
Examiner Varcoe	Art Unit 1764



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 27, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Presently claims 1-7 and 13-15 are active in this application. Claims 8-12 have been withdrawn from consideration as non-elected, but have not yet been canceled.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruhl, EP 0 450 872 A1. The grounds are the same as in the last Officer action.

Response to Arguments

2. Applicant's July 27, 2001, arguments with respect to claims 1-7 and 13-15 have been considered but are not convincing.

Applicant argues that since the '872 patent discloses preheaters known in the art and commercially available, and that those preheaters are normally not capable of heating combustion air hot enough for flameless combustion. An implied conclusion is that the '872 patent lacks all the structural elements required for flameless combustion. Examiner notes that at lines 13 and 55 of page 5, the '872 patent discloses heating above the autoignition temperature. It would appear from this that the '872 apparatus provides sufficiently high temperatures for flameless combustion to occur.

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Applicant argues that the apparatus of '872 does not necessarily lack a flame, and that in order for an element in a claim to be considered inherent, that element must necessarily be present. The conclusion is that flameless operation is not an inherent part of the '872 apparatus. Examiner notes that flameless operation is not a claim element in an apparatus claim. In order to reject an apparatus claim under 35 U.S.C. 102(b), it is the apparatus elements that must be present, not method of use elements. As long as the prior art apparatus is capable of use according to the claims of the present invention, the prior art is acceptable for use in a rejection.

Applicant mentions "... elements of the present [apparatus] invention that require flameless combustion" Examiner is not aware of which structural elements Applicant is referring to. If there were such, they would clearly have to be lacking in the '872 disclosure since '872 mentions flame combustion as an option.

It appears that both the invention of the Applicant and the apparatus of the '872 patent are capable of both flameless and flame operation. There does not seem to be any structural feature in either of the two apparatus that prohibits either of the two modes of operation. Operation of Applicant's invention in flameless mode being a method of use and not a structural feature, the invention is not distinguished over the '872 patent.

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Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Varcoe, whose telephone number is (703) 306-5477. The examiner can normally be reached Monday through Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached on (703) 308-4311.

The FAX telephone number for this Group Art Unit is (703) 305-3599 (for Official papers after Final), (703) 305-5408 (for other Official papers) and (703) 305-6357 (for Unofficial papers).

When filing a FAX in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing your papers.


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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

RV
October 8, 2001



HIEN TRAN
PRIMARY EXAMINER